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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/712,792
Filing Date: November 12, 2003
Appellant(s): KUSHNER, ROBERT GERALD

Stuart A. Whittington
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 8, 2007 and the amended appeal brief filed March 6, 2009 appealing from the Office action mailed February 7, 2007. This is also in response to the remand mailed January 13, 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,728,995	Ainley et al.	5-2004
5,180,133	Chang	1-1993
6,681,452	Holland	1-2004
6,101,689	Jo	8-2000
6,178,085	Leung	1-2001
JP 10-226279	Suzuki et al.	8-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 7, 17 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al. (JP 10226279A).

Suzuki et al. disclose a spectacles holder (Fig 1) with clamping means comprising an upper arm (12) and lower arm (13) further comprising a clasp means (12c, 12d, 12e) for securing the clamping means in a clamped position ([0020]), cushion

means (4) to secure and support the personal item in the clamping means, attachment means (2) to attach the clamping means to a desired surface, where the attachment means comprises a clip, and tool securing means (11) for securing a provided tool (20) to said clamping means, which include a cavity or recess (between 11 and 12) dimensioned to accommodate the provided tool.

Claims 1, 2, 7, 9, 10, 11, 14, 17, 18 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ainley et al. (US 6,728,995) in view of Chang (US 5,180,133).

Ainley et al. disclose a spectacles caddy comprising a comprising a clamping body (fig 1) having a clamping position and an open position and comprising an upper arm (3) with a cushion member (19); a lower arm (2) with a cushion member (18), the lower arm being pivotally connected at one end of thereof to a corresponding end of the upper arm such that personal articles, including spectacles as well as other items (Col 1, lines 30-31) may be retained between the cushions of the upper and lower arms, said clamping body also having a cavity formed therein (un-numbered recess in the top middle face of 3, seen clearly to be a recess again in figure 4, where the 1 is pointing to). Ainley et al. also disclose an attachment means (5) connected to the clamping body. However, Ainley et al. fail to disclose a tool operative to be removably inserted into the cavity.

Chang discloses a calculator (Fig 4, 60) to be removably inserted into a cavity on a similar clamping body, ie. Pivoting members that hold objects there between.

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Mounting the calculator allows it to be used with one hand as the calculator is supported by another structure. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the recess of Ainley et al. in such a manner to be able to removably insert a calculator, as taught by Chang in order to hold a calculator and provide a convenient mounting surface for the calculator.

In regards to claims 7, 14, 18 and 21, Ainley et al. disclose an attachment means comprising a clip (fig 1, 4 or col 2, line 49).

In regards to claims 10, 20 and 22, Ainley et al. disclose the two arms, as well as the cavity of the design being composed of injection-molded plastic (Col 3, line 63-64).

In regards to claim 17, Ainley et al. disclose the clamping means including a clasp member (21, Col 3, lines 24-30) to secure the clamping means in a closed position.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ainley et al. (US 6,728,995) in view of Chang (US 5,180, 133) as applied to claims 1, 2, 6, 7, 9, 10, 11, 14, and 17 above, and further in view of Leung (US 6,178,085).

Ainley et al., as modified above, disclose all the limitations of the claim except for a rotatable panel on the calculator operative in a first position to protect at least one of the keypad or display and in a second position to support the calculator in a substantially upright position.

Leung discloses a calculator with a rotating cover (fig 10, 24) with a first operative position to cover the calculators display panel (fig 1) and a second operative

position to form a stand for a calculator (fig 10; Col 4, lines 30-32). This allows the cover to protectively shield the keypad and display (Col 3, lines 3-4) while also propping the calculator at an angle when set on a desktop (Col 4, lines 40-41). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the eyeglass clip of Ainley et al. with the rotating cover taught by Leung in place of the basic calculator taught by Chang in order to provide protection for the keypad and display of the calculator and also allow it to be removed from the stand and propped up on a desktop.

Claims 1, 2, 7, 9, 11, 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holland (US 6,681,452) in view of Jo (US 6,101,689).

Holland discloses an article holder (Fig 4) with an upper arm (14), a lower arm (12) pivotally connected at one end thereof (the bottom end of the upper arm or the top end of the lower arm) to the upper arm to form a clamping body wherein personal items are secured between the arm members (between 15a and 13a), the lower arm further comprising an attachment portion (12b, see also Fig 2, 11) opposite the holding area. Holland further discloses a cavity (14a) in the upper arm and a tool (Fig 8, 330) which is disclosed as a calculator (Col 6, 15-17) operative to be removably inserted into said cavity. Holland does not disclose a cushion disposed on the bottom side of the upper arm, opposite the tool holding cavity, a cushion on the top side of the lower arm, opposite the attachment portion or the attachment portion comprising a clip.

Jo discloses a personal article holder (Fig 3) comprising an upper arm (10), a lower arm (11) and an attachment clip (12) to hold the clip to a belt (26) or other clothing (Col 2, lines 53-55). Furthermore, Jo discloses two cushions, a first cushion (16) on the bottom of the upper arm, and a second cushion (18) on the top of the lower arm where these cushions work together to ensure a secure grip on the object held, as well as help avoid disfiguring the item in question (Col 2, lines 66-67). Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to make the article holder of Holland with the cushions and attachment clip of Jo in order to securely grip the item being held without damaging it, as well as to attach the object holder onto the clothing of a user.

Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holland (US 6,681,452) in view of Jo (US 6,101,689) as applied to claims 1, 2, 7, 9, 11, 14 and 18 above, and further in view of Ainley et al. (US 6,728,995).

Holland as modified above discloses all the limitations of the claims except for the upper and lower arm members formed from an injection molded plastic material, though Holland does disclose the upper and lower arm members being made from polymeric materials, which are plastics (Col 3, lines 31-34).

Ainley et al. disclose a hinged object carrier (Fig 1) whose arms (2, 3) are fabricated as injection moldings from a rigid plastic (Col 3, lines 63-65). As injection molding is a well known method for inexpensively manufacturing plastic objects, it would have been obvious to one of ordinary skill in the art at the time of invention to create the

article holder of Holland as modified above with injection molded plastic arms in order to save money during production.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holland (US 6,681,452) in view of Jo (US 6,101,689) as applied to claims 1, 2, 7, 9, 11, 14 and 18 above, and further in view of Leung (US 6,178,085).

Holland as modified above discloses all the limitations of the claim except for a rotatable panel on the calculator operative in a first position to protect at least one of the keypad or display and in a second position to support the calculator in a substantially upright position.

Leung discloses a calculator with a rotating cover (fig 10, 24) with a first operative position to cover the calculators display panel (fig 1) and a second operative position to form a stand for a calculator (fig 10; Col 4, lines 30-32). This allows the cover to protectively shield the keypad and display (Col 3, lines 3-4) while also propping the calculator at an angle when set on a desktop (Col 4, lines 40-41). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the article holder of Holland's removable calculator (Fig 8, 330) as modified above with the rotating cover taught by Leung in order to provide protection for the keypad and display of the calculator and also allow it to be removed from the article holder and be propped up on a desktop.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holland (US 6,681,452) in view of Jo (US 6,101,689) and Ainley et al. (US 6,728,995) as applied to claims 10 and 20 above, and further in view of Suzuki et al. (JP 10226279).

Holland as modified above discloses all the limitations of the claim except for the upper and lower arms being formed specifically of Acrylnitrile-Butadiene-Styrene (ABS) plastic although they do disclose the upper and lower arms as being formed of injection molded plastic (See above).

Suzuki et al. disclose a case formed of ABS resin. ABS is well known for being a plastic with high impact resistance and toughness. It would have been obvious to one of ordinary skill in the art to create the arm members of Holland as modified above with the ABS plastic of Suzuki et al. in order to gain the benefit of ABS plastic's increased impact resistance and toughness.

Claims 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (JP 10226279) in view of Ainley et al. (US 6,728,995).

Suzuki et al. disclose all the limitations of the claims except for the clamping means comprising an upper and a lower arm formed of injection molded plastic.

Ainley et al. disclose a spectacles caddy which is comprised of injection molded plastic (Col 3, lines 63-64). As Suzuki et al. disclose a case formed of plastic, specifically ABS resin ([0014]), and injection molding is a well known method for inexpensively mass-producing plastic items, It would have been obvious to one of

ordinary skill in the art at the time of invention to make the spectacles caddy of Suzuki et al. with the injection molded plastic of Ainley et al. in order to inexpensively produce the spectacles caddy.

(10) Response to Argument

A. Claims 1, 7, 17 and 21 as anticipated by Suzuki et al. (JP 10226279A).

In regards to the 102 and 103 rejections with Suzuki et al. appellant argues that Suzuki does not disclose a tool to be removably inserted into the cavity, specifically that “element 20 is not a tool within the context of Appellant’s specification, it is a card such as a business card.” (Brief, page 6, lines 3-4). Appellant further asserts that in claim 17, 35 USC 112, sixth paragraph is invoked, and that the ““tool securing means” structure (e.g., Figs. 3,5,6) disclosed in the specification is indisputably different than the card holder disclosed by Suzuki” (Brief, page 7, lines 3-5). Appellant finally asserts that no cavity is formed in the clamping body, and includes a separate arm member (11) to hold its cards (Brief, page 7, lines 10-12).

In response to appellant’s argument that Suzuki does not disclose a tool operative to be inserted into a cavity, on the grounds that a card is not a tool. (Page 3 of response of 5/7/07). Suzuki discloses a number of cards, from Highway Cards to gas cards to business cards, all of which are tools for various purposes. For example, a business card does meet the limitations of the term tool as presented by appellant’s claims, as a business card is a tool which facilitates business communications.

In response to appellant's argument that Suzuki discloses tool securing means different than appellant, this is true, however examiner is unable to find a section of appellant's specification (and none was set forth in the brief) which sets forth the structure of the tool securing means. Paragraph [0024] of the specification states "tool 26 may be retained therein by virtue of one or more indentation and/or tabs on the cavity or tool." Suzuki does disclose the tool being held by "indentation and/or tabs" as seen in Figure 1, the indentation being formed in both the upper arm (12) and the additional tool securing means (11) as well as the additional tool securing means (11) as a whole being able to be interpreted as a tab.

In response to appellant's argument that Suzuki does not disclose a cavity on the upper arm (12) of the clamping body, a review of Figure 2 of Suzuki shows a cavity in the upper arm (12) facing the additional tool securing means (11), the additional tool securing means also forming part of the upper arm.

B. Claims 1, 2, 7, 9, 10, 11, 14, 17, 18 and 20-22 are unpatentable over Ainley et al. (US 6,728,995) in view of Chang (US 5,180,133).

In regards to the 103 rejections of Ainley et al. (US 6,728,995) in view of Chang (US 5,180,133) and others appellant argues that there is no motivation for the combination of Ainley et al. and Chang to "configure the recess of Ainley et al. in a manner to be able to removably insert Chang's calculator". Appellant further argues that the "cavity" of Ainley is not a cavity into which a tool could be insertably removed

and further that “while the Chang clipboard may include such a cavity, Chang’s clip omits several other elements expressly claimed by Appellant”.

In response to appellant’s argument that there is no motivation to combine Ainley and Chang, examiner has provided a reason, namely “in order to provide a convenient mounting surface for the calculator.” In regards to this argument, examiner points to the response to arguments in the Office Action of February 7, 2007. Further evidence of the properness of this combination was set forth in the advisory action of the examiner and will be reiterated herein, namely the patents of Decoteau (US 6,502,727) which discloses an electronic device (Fig 1, 30, Col 1, lines 16-17) clipped (14) to a vehicle sun visor (Col 2, lines 62-64) and Rall et al. (US 2004/0108228 A1) which discloses a note organizer (Fig 1-5) which may be clipped to a sun visor (Fig 2) and also may be provided with a calculator (Fig 5, 38) depending on the specific needs of the vehicle in question [0014]. Examiner provided these as evidence that it was known to be desirable at the time of invention to locate a calculator on a visor.

In response to appellant’s argument that the “cavity” of Ainley is not a cavity into which a tool could be insertably removed and further that “while the Chang clipboard may include such a cavity, Chang’s clip omits several other elements expressly claimed by Appellant”, appellant fails to set forth reasons for why the cavity of Ainley is unable to have a tool insertably removed or what elements the Chang clip omits that are not met by the combination of Ainley in view of Chang. Due to this, examiner is unable to respond directly to these allegations, other than to point to the rejections set forth above.

C. Claim 8 is unpatentable over Ainley in view of Chang and in further view of Leung.

Appellant does not argue the addition of Leung except to state that Leung does not remedy the deficiencies of Ainley in view of Chang. As such no further response is needed.

D. Claims 1, 2, 7, 9, 11, 14 and 18 are unpatentable over Holland (US 6,681,452) in view of Jo (US 6,101,689).

In regards to the 103 rejections of Holland (US 6,681,452) in view of Jo (US 6,101,689) appellant argues that there is no objective reason to combine Holland and Jo as stated by examiner as there is no reason to assume that the clamp of Holland would damage an item, and that there is already a hanging apparatus disclosed on Holland. Appellant further argues that the examiner has given undue breadth to the term "end" regarding the location of the pivoting motion of the two arms.

In response to the alleged lack of an objective reason to add the cushions of Jo to the clamp of Holland, Holland discloses holding documents and/or other objects (Col 1, lines 35-36) and Jo teaches the cushions in order to carry an item between the jaws, regardless of the thickness of the item. (Col 1, lines 55-62). Thus the cushions of Jo would allow Holland to securely grip items of varying sizes more effectively.

In response to the alleged lack of an objective reason to add the clip of Jo to the clamping apparatus of Holland, while Holland discloses attaching the clamping apparatus to various objects via magnets, adhesives and/or fasteners of various types (Col 6, lines 29-34). Jo teaches a clip to attach a clamping apparatus to a user's

clothing. Thus, as stated above, one of ordinary skill in the art would look to Jo for a teaching of a clip to attach the object holder to a supporting surface, such as a user's clothing.

In response to appellant's argument that Holland does not disclose a pivoting member at corresponding ends as recited by appellant, Examiner's use of the top and bottom ends of the arms does not give the claims undue breadth, as an "end" is not further defined by appellants claims, and thus Examiner uses the broadest reasonable interpretation of the term. Moreover, as set forth in the advisory action, an alternative interpretation (indeed the one appellant argues is the only reasonable interpretation), Holland could have two ends, one which extended from the grasping means (13a) toward the pivot point (specifically up to right before the pivot point) and a second end from the front of the pivot point to the rear holding means of the clamping body (13b).

E. Claims 10 and 20 are unpatentable over Holland in view of Jo and in further view of Ainley.

Appellant does not argue the addition of Ainley except to state that Ainley does not remedy the deficiencies of Holland in view of Jo. As such no further response is needed.

F. Claim 8 is unpatentable over Holland in view of Jo and in further view of Leung.

Appellant does not argue the addition of Leung except to state that Leung does not remedy the deficiencies of Ainley in view of Chang. As such no further response is needed.

G. Claim 19 is unpatentable over Holland in view of Jo in view of Ainley and in further view of Suzuki.

Appellant does not argue the addition of Suzuki except to state that Suzuki does not remedy the deficiencies of Holland in view of Jo. As such no further response is needed.

H. Claims 19 and 22 are unpatentable over Suzuki in view of Ainley.

Appellant does not argue the limitations of claims 19 and 22 respectively, but argues that each of the independent claims 1 and 17 are not met either alone or in combination by Suzuki and Ainley respectively. Whether the claims 1 and 17 are met by Suzuki had been addressed in paragraph A above and therefore no further response is needed. With respect to claims 19 and 22, as appellant does not argue the limitations of these claims, no further response is needed.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/JHM/

April 22, 2009

Conferees:

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